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08/325,219 10/21/94 SCHADE

C 43168

EXAMINER

CHENG, W

15M2/0427

ART UNIT PAPER NUMBER

#5

KEIL AND WEINKAUF  
1101 CONNECTICUT AVENUE N W  
WASHINGTON DC 20036

1505

DATE MAILED: 04/27/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ \_\_\_\_\_

Part II SUMMARY OF ACTION

- ☒ Claims 10-16 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
- ☐ Claims \_\_\_\_\_ have been cancelled.
- ☐ Claims \_\_\_\_\_ are allowed.
- ☒ Claims 10-16 are rejected.
- ☐ Claims \_\_\_\_\_ are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
- ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

Art Unit 1505

15.

Claims 10-14 and 16 provide for the use of the copolymer in claim 15, but does not set forth any steps involved in the process. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Ex parte Erlich, 3 USPQ 2d 1011 (Bd. PA&I. 1986).

16.

Claims 10-14 and 16 are rejected under 35 U.S.C. § 101 because the claimed recitation of a use without setting forth any steps involved in the process results in an improper definition of a process, i.e., in a claim which is not a proper process claim under 35 USC 101. See for example Ex parte Dunki, 153 USPQ 678 (Bd. App. 1967) and Clinical Products Ltd. V. Brenner, 255 F.Supp. 131, 149 USPQ 475 (D.D.C. 1966).

17.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Serial No. 08/325,219

-3-

Art Unit 1505

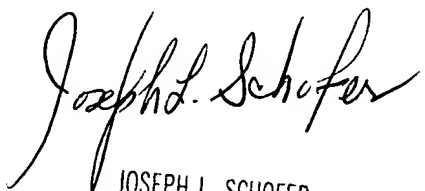
Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

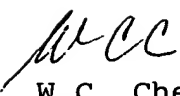
Claim 1 is rejected under 35 U.S.C. § 103 as being unpatentable over Fock et al. (DE 3 925 220).

Fock et al. disclose a copolymer of methacrylic acid and alkyl allyl ethers which may contain up to 25 alkylene oxide units. Alkyl vinyl ethers are homologs of alkylallyl ethers. Homologs would be expected to have same properties. See In re Henze 85 USPQ 261.

18.

Any inquiry concerning this communication should be directed to W.C. Cheng whose telephone number is (703) 308-2351.

  
JOSEPH L. SCHOFER  
SUPERVISORY PATENT EXAMINER  
ART UNIT 155

  
W.C. Cheng:amc  
April 22, 1995